

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Andreas FATH

Serial No.: 10/534,560

Examiner: M. Lavilla

Filing Date: December 22, 2006

Art Unit: 1794

For: **COATING METHOD**

Docket No.: D4700-00394

Customer No.: 08933

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This is in response to the Restriction Requirement dated January 14, 2010. The Examiner requires an election among Group I (claims 1-17 and 27-32), drawn to a method for coating articles; Group II (claims 18-25 and 33-35), drawn to a coated article; or Group III (claims 26, 36 and 37), drawn to a coating composition.

Applicants hereby provisionally elect to prosecute Group I, claims 1-17 and 27-32. This election is made with traverse.

In addition, the Examination of all groups concurrently is requested, given the commonality of subject matter among the groups. The Manual of Patent Examining Procedure (M.P.E.P.) recites the requirements for a proper restriction requirement. In particular, the M.P.E.P. states:

There are two criteria for a proper requirement for restriction between patentably distinct inventions:

(A) The inventions must be independent (see MPEP Section 802.01, Section 806.06, Section 808.01) or distinct as claimed (see MPEP Section 806.05 – Section 806.05(j)); *and*

(B) There would be a serious burden on the examiner if restriction is not required (see MPEP Section 803.02, Section 808, and Section 808.02).

(M.P.E.P. § 803 (emphasis added)). The fact that *both* criteria must be satisfied is made all the more clear by the following statement in the M.P.E.P.:

If the search and examination of all the claims in an application can be made without serious burden, the examiner *must* examine them on the merits, even though they include claims to independent or distinct inventions.

(M.P.E.P. § 803 (emphasis added)).

Thus, if the subject matter of the pending claims is such that there would be no serious burden on the examiner to search and examine all of the pending claims at the same time, the examiner is to do so, *even if* the pending claims are drawn to independent or distinct inventions.

Applicants respectfully submit that the claims of Groups I, II and III are closely related such that examination of all groups would not pose an undue burden on the Examiner. The Examiner would have to review substantially the same prior art to examine Groups II and III as is already being searched and reviewed in order to examine the elected Group I. Accordingly, reconsideration and withdrawal of the restriction requirement is respectfully requested.

Respectfully submitted,

Dated: March 19, 2010

/Richard A. Paikoff/
Richard A. Paikoff
Registration No. 34,892
Duane Morris LLP
30 South 17th Street
Philadelphia, PA 19103-4196
Telephone: 215.979.1853
Facsimile: 215.689.3640
mail to: rapaikoff@duanemorris.com